

a given product, an independent claim for a process specifically adapted for the manufacture of said product, and an independent claim for a use of said product" (PCT Gazette, page 9475, section (e)). Accordingly, Group II, claim 12, directed to a process of making the compound of Formula I, depicted in claim 1, should be grouped with the claims of Group I. Moreover, The PCT Gazette further states that "the words 'specially adapted' are not intended to imply that the product could not also be manufactured by a different process" (PCT Gazette, page 9475, section (e)). Accordingly, more than one process "specially adapted" to the manufacture of a certain product can be claimed without contravening the unity of invention requirement and claims of Group III, claims 13 and 14; Group IV, claims 15-22; and Group V, claims 23-30 should be included with the claims of Group I.

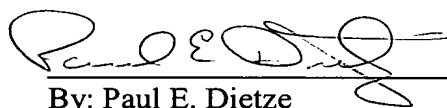
PCT Rule 13 also governs situations involving intermediates and final products. Specifically, the PCT Gazette states that unity of invention is considered to be present if "the basic chemical structures of the intermediate and the final product are the same" (PCT Gazette, page 9476, section (g)). Furthermore, the PCT Gazette states that "it is possible to accept in a single international application different intermediate products used in different processes for the preparation of the final product, provided that they have the same essential structural element" (PCT Gazette, page 9475, section (g)(ii)(B)(iv)). Accordingly, the intermediates claimed in claims 35, 37, 39, 41, and 43, that all share as an essential structural element with the compound of Formula I the baccatin IV configuration, in particular, the 7- β epimer should also be included in the claims of Group I.

For the above reasons, Applicants respectfully submit that claims 1, 12, 13, 14, 15-22, 23-30, 35, 37, 39, 41, and 43 should all be included in the claims of Group I. Accordingly, Applicants respectfully request that the restriction requirement be reconsidered and withdrawn.

No fee is believed to be due for the submission of this response. Should any fees be required, please charge such fees to Pennie & Edmonds deposit account no. 16-1150.

Respectfully submitted,

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GAZETTE OF INTERNATIONAL PATENT LITIGATION

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ADMINISTRATIVE INSTRUCTIONS
UNDER THE PCT



ANNEX B

UNITY OF INVENTION

PART I

INSTRUCTIONS CONCERNING UNITY OF INVENTION

(a) **Unity of invention.** Rule 13.1 deals with the requirement of unity of invention and states the principle that an international application should relate to only one invention or, if there is more than one invention, that the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept.

(b) **Technical Relationship.** Rule 13.2 defines the method for determining whether the requirement of unity of invention is satisfied in respect of a group of inventions claimed in an international application. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding "special technical features." The expression "special technical features" is defined in Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).

(c) **Independent and Dependent Claims.** Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression "category of claim" referring to the classification of claims according to the subject matter of the invention claimed - for example, product, process, use or apparatus or means, etc.).

(i) If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. Equally, no problem arises in the case of a genus/species situation where the genus claim avoids the prior art. Moreover, no problem arises in the case of a combination/subcombination situation where the subcombination claim avoids the prior art and the combination claim includes all the features of the subcombination.

(ii) If, however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity *a posteriori* (that is, arising only after assessment of the prior art) may be raised. Similar considerations apply in the case of a genus/species or combination/subcombination situation.

(iii) This method for determining whether unity of invention exists is intended to be applied even before the commencement of the international search. Where a search of the prior art is made, an initial determination of unity of invention, based on the assumption that the claims avoid the prior art, may be reconsidered on the basis of the results of the search of the prior art.

(d) **Illustrations of Particular Situations.** There are three particular situations for which the method for determining unity of invention contained in Rule 13.2 is explained in greater detail:

- (i) combinations of different categories of claims;
- (ii) so-called "Markush practice"; and
- (iii) intermediate and final products.

Principles for the interpretation of the method contained in Rule 13.2, in the context of each of those situations are set out below. It is understood that the principles set out below are, in all instances, interpretations of and not exceptions to the requirements of Rule 13.2.

Examples to assist in understanding the interpretation on the three areas of special concern referred to in the preceding paragraph are set out below.

(e) **Combinations of Different Categories of Claims.** The method for determining unity of invention under Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

- (i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or
- (ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or
- (iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process,

it being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product and that an apparatus or means is specifically designed for carrying out a process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art.

Thus, a process shall be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product with the technical relationship being present between the claimed product and claimed process. The words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process.

Also an apparatus or means shall be considered to be "specifically designed for carrying out" a claimed process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art. Consequently, it would not be sufficient that the apparatus or means is merely capable of being used in carrying out the claimed process. However, the expression "specifically designed" does not imply that the apparatus or means could not be used for carrying out another process, nor that the process could not be carried out using an alternative apparatus or means.

(f) **"Markush Practice."** The situation involving the so-called "Markush practice" wherein a single claim defines alternatives (chemical or non-chemical) is also governed by Rule 13.2. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2, shall be considered to be met when the alternatives are of a similar nature.

(ANNEX B, CONTINUED)

PART 2

EXAMPLES CONCERNING UNITY OF INVENTION

The application of the principles of unity of invention is illustrated by the following examples for guidance in particular cases.

I CLAIMS IN DIFFERENT CATEGORIES

Example 1

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Claim 3: The use of substance X as an insecticide.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X.

Example 2

Claim 1: A process of manufacture comprising steps A and B.

Claim 2: Apparatus specifically designed for carrying out step A.

Claim 3: Apparatus specifically designed for carrying out step B.

Unity exists between claims 1 and 2 or between claims 1 and 3. There is no unity between claims 2 and 3 since there exists no common special technical feature between the two claims.

Example 3

Claim 1: A process for painting an article in which the paint contains a new rust inhibiting substance X including the steps of atomizing the paint using compressed air, electrostatically charging the atomized paint using a novel electrode arrangement A and directing the paint to the article.

Claim 2: A paint containing substance X.

Claim 3: An apparatus including electrode arrangement A.

Unity exists between claims 1 and 2 where the common special technical feature is the paint containing substance X, or between claims 1 and 3 where the common special technical feature is the electrode arrangement A.

However, unity is lacking between claims 2 and 3 since there exists no common special technical feature between them.

Example 4

Claim 1: Use of a family of compounds X as insecticides.

Claim 2: Compound X₁ belonging to family X.

Provided X₁ has the insecticidal activity and the special technical feature in claim 1 is the insecticidal use, unity is present.

Example 5

Claim 1: A process for treating textiles comprising spraying the material with a particular coating composition under special conditions (e.g., as to temperature, irradiation).

Claim 2: A textile material coated according to the process of claim 1.

Claim 3: A spraying machine for use in the process of claim 1 and characterized by a new nozzle arrangement providing a better distribution of the composition being sprayed.

The process according to claim 1 imparts unexpected properties to the product of claim 2.

The special technical feature in claim 1 is the use of special process conditions corresponding to what is made necessary by the choice of the particular coating. Unity exists between claims 1 and 2.

The spraying machine in claim 3 does not correspond to the above identified special technical feature. Unity does not exist between claim 3 and claims 1 and 2.

Example 6

Claim 1: A fuel burner with tangential fuel inlets into a mixing chamber.

Claim 2: A process for making a fuel burner including the step of forming tangential fuel inlets into a mixing chamber.

Claim 3: A process for making a fuel burner including casting step A.

Claim 4: An apparatus for carrying out a process for making a fuel burner including feature X resulting in the formation of tangential fuel inlets.

Claim 5: An apparatus for carrying out a process for making a fuel burner including a protective housing B.

Claim 6: A process of manufacturing carbon black including the step of tangentially introducing fuel into a mixing chamber of a fuel burner.

Unity exists between claims 1, 2, 4 and 6. The special technical feature common to all the claims is the tangential fuel inlets. Claims 3 and 5 lack unity with claims 1, 2, 4 and 6 since claims 3 and 5 do not include the same or corresponding special technical feature as set forth in claims 1, 2, 4 and 6. Claims 3 and 5 would also lack unity with one another.

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Example 7

Claim 1: A high corrosion resistant and high strength ferritic stainless steel strip consisting essentially of, in percent by weight: Ni=2.0-5.0; Cr=15-19; Mo=1-2; and the balance Fe having a thickness of between 0.5 and 2.0 mm and a 0.2% yield strength in excess of 50 kg/mm squared.

Claim 2: A method of producing a high corrosion resistant and high strength ferritic stainless steel strip consisting essentially of, in percent by weight: Ni=2.0-5.0; Cr=15-19; Mo=1-2; and the balance Fe, comprising the steps of:

hot rolling to a thickness between 2.0 and 5.0 mm;

annealing the hot rolled strip at 800-1000 degrees C under substantially non-oxidizing conditions;

cold rolling the strip to a thickness of between 0.5 and 2.0 mm; and final annealing the cold rolled strip at between 1120 and 1200 degrees C for a period of 2-5 minutes.

Unity exists between product claim 1 and process claim 2. The special technical feature in the product claim is the 0.2% yield strength in excess of 50 kg/mm squared. The process steps in claim 2 inherently produce a ferritic stainless steel strip with a 0.2% yield strength in excess of 50 kg/mm squared. Even if this feature is not apparent from the wording of claim 2, it is clearly disclosed in the description. Therefore said process steps are the special technical feature which correspond to the limitation in the product claim directed to the same ferritic stainless steel with the claimed strength characteristics.

II CLAIMS IN THE SAME CATEGORY

Example 8

Claim 1: Plug characterized by feature A.

Claim 2: Socket characterized by corresponding feature A.

Feature A is a special technical feature which is included in both claims 1 and 2 and therefore unity is present.

Example 9

Claim 1: Transmitter provided with time axis expander for video signals.

Claim 2: Receiver provided with time axis compressor for video signals received.

Claim 3: Transmission equipment for video signals comprising a transmitter provided with time axis expander for video signals and a receiver provided with time axis compressor for video signals received.

The special technical features are in claim 1 the time axis expander, and in claim 2 the time axis compressor, which are corresponding technical features. Unity exists between claims 1 and 2. Claim 3 includes both special technical features and has unity with claims 1 and 2. The requirement for unity would still be met in the absence of the combination claim (claim 3).

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Example 10

Claim 1: Conveyor belt with feature A.

Claim 2: Conveyor belt with feature B.

Claim 3: Conveyor belt with features A + B.

Feature A is a special technical feature and feature B is another unrelated special technical feature. Unity exists between claims 1 and 3 or between claims 2 and 3, but not between claims 1 and 2.

Example 11

Claim 1: Control circuit A for a d.c. motor.

Claim 2: Control circuit B for a d.c. motor.

Claim 3: An apparatus including a d.c. motor with control circuit A.

Claim 4: An apparatus including a d.c. motor with control circuit B.

Control circuit A is a special technical feature and control circuit B is another unrelated special technical feature. Unity exists between claims 1 and 3 or between claims 2 and 4, but not between claims 1 and 2 or 3 and 4.

Example 12

Claim 1: A display with features A + B.

Claim 2: A display according to claim 1 with additional feature C.

Claim 3: A display with features A + B with additional feature D.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is features A + B.

Example 13

Claim 1: Filament A for a lamp.

Claim 2: Lamp B having filament A.

Claim 3: Searchlight provided with lamp B having filament A and a swivel arrangement C.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is the filament A.

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Example 14

Claim 1: A marking device for marking animals, comprising a disc-shaped element with a stem extending normally therefrom, the tip of which is designed to be driven through the skin of the animal to be marked, and a securing disc element to be fastened to the protruding tip of the stem on the other side of skin.

Claim 2: An apparatus for applying the marking device of claim 1, constructed as a pneumatically actuated gun for driving the stem of the disc-shaped element through the skin, and provided with a supporting surface adapted for taking up a securing disc element, to be placed at the other side of the body portion in question of the animal to be marked.

The special technical feature in claim 1 is the marking device having a disc-shaped element with a stem and a securing disc element to be fastened to the tip of the stem. The corresponding special technical feature in claim 2 is the pneumatically actuated gun for driving the marking device and having a supporting surface for the securing disc element. Unity exists between claims 1 and 2.

Example 15

Claim 1: Compound A.

Claim 2: An insecticide composition comprising compound A and a carrier.

Unity exists between claims 1 and 2. The special technical feature common to all the claims is compound A.

Example 16

Claim 1: An insecticide composition comprising compound A (consisting of a_1 , a_2 ...) and a carrier.

Claim 2: Compound a_1 .

All compounds A are not claimed in the product claim 2 for reasons of lack of novelty of some of them for instance. There is nevertheless still unity between the subject matter of claims 1 and 2 provided a_1 has the insecticidal activity which is also the special technical feature for compound A in claim 1.

Example 17

Claim 1: Protein X.

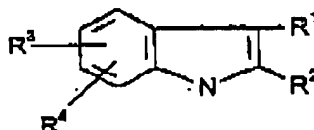
Claim 2: DNA sequence encoding protein X.

Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claims 1 and 2 is accepted.

III. MARKUSH PRACTICE

Example 18 - common structure:

Claim 1: A compound of the formula:

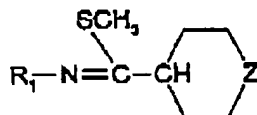


wherein R^1 is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy and methyl; R^2 - R^4 are methyl, benzyl or phenyl. The compounds are useful as pharmaceuticals for the purpose of enhancing the capacity of the blood to absorb oxygen.

In this case the indolyl moiety is the significant structural element which is shared by all of the alternatives. Since all the claimed compounds are alleged to possess the same utility, unity is present.

Example 19 - common structure:

Claim 1: A compound of the formula:

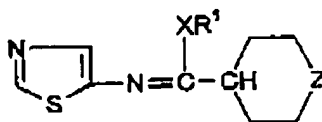


wherein R_1 is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy and methyl; Z is selected from the group consisting of oxygen (O), sulfur (S), imino (NH) and methylene ($-\text{CH}_2-$). The compounds are alleged to be useful as pharmaceuticals for relieving lower back pain.

In this particular case the iminothioether group $-\text{N}=\text{C}-\text{SCH}_3$ linked to a six atom ring is the significant structural element which is shared by all the alternatives. Thus, since all the claimed compounds are alleged to possess the same use, unity would be present. A six membered heterocyclic ring would not have been of sufficient similarity to allow a Markush grouping exhibiting unity, absent some teaching of equivalence in the prior art.

Example 20 - common structure:

Claim 1: A compound of the formula:



wherein R^1 is methyl or phenyl, X and Z are selected from oxygen (O) and sulfur (S).

The compounds are useful as pharmaceuticals and contain the 1,3-thiazolyl substituent which provides greater penetrability of mammalian tissue which fact makes the compounds useful as relievers for headaches and as topical anti-inflammatory agents.

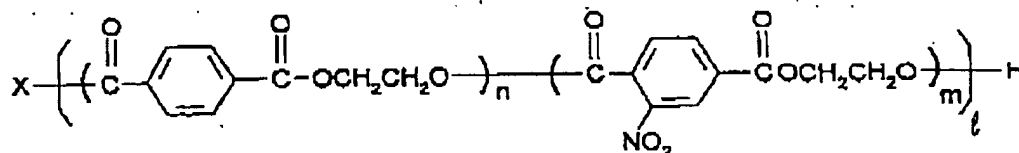
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All compounds share a common chemical structure, the thiazole ring and the six atom heterocyclic compound bound to an imino group, which occupy a large portion of their structure. A six membered heterocyclic ring would not have been of sufficient similarity to allow a Markush grouping exhibiting unity, absent some teaching of equivalence in the prior art.

Example 21 - common structure:



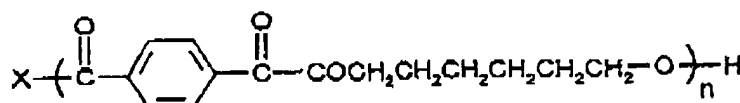
$$1 \leq l \leq 10$$

$$200 \geq n + m \geq 100$$



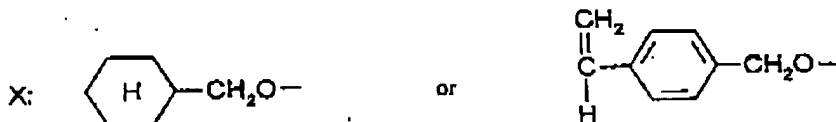
All of the above copolymers have in common a thermal degradation resistance property, due to the reduced number of free COOH radicals by esterification with X of the end COOH radicals which cause thermal degradation. The chemical structures of the alternatives are considered to be technically closely interrelated to one another. A grouping in one claim is therefore allowed.

Example 22 - common structure:



(polyhexamethyleneterephthalate)

$$100 \geq n \geq 50$$



The compound obtained by esterifying the end COOH radical of known polyhexamethyleneterephthalate with has a thermal degradation resistant property, due to the reduced number of free COOH radicals which cause thermal degradation. In contrast, the compound obtained by esterifying the end COOH radical of known polyhexamethyleneterephthalate with a vinyl compound containing a $\text{CH}_2 = \text{CH}-\text{C}_6\text{H}_4-\text{CH}_2\text{O}-$ moiety serves as a raw material for a setting resin when mixed with unsaturated monomer and cured (addition reaction).

All esters covered by the claim do not have a property of activity in combination. For example, the product obtained through esterification with the " $\text{CH}_2 = \text{CH}$ " vinyl compound does not.

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have a thermal degradation resistant property. The grouping in a single application is not allowed.

Example 23 - No common structure:

Claim 1: A herbicidal composition consisting essentially of an effective amount of the mixture of A 2,4-D(2,4-dichlorophenoxy acetic acid) and B a second herbicide selected from the group consisting of copper sulfate, sodium chlorate, ammonium sulfamate, sodium trichloroacetate, dichloropropionic acid, 3-amino-2,5-dichlorobenzoic acid, diphenamid (an amide), ioxynil (nitrile), dinoseb (phenol), trifluralin (dinitroaniline), EPTC (thiocarbamate) and simazine (triazine) along with an inert carrier or diluent.

The different components under B must be members of a recognized class of compounds. Consequently in the present case a unity objection would be raised because the members of B are not recognized as a class of compounds, but, in fact, represent a plurality of classes which may be identified as follows:

- a) inorganic salts:
 - copper sulfate
 - sodium chlorate
 - ammonium sulfamate
- b) organic salts and carboxylic acids:
 - sodium trichloroacetate
 - dichloropropionic acid
 - 3-amino-2,5-dichlorobenzoic acid
- c) amides:
 - diphenamid
- d) nitriles:
 - ioxynil
- e) phenols:
 - dinoseb
- f) amines:
 - trifluralin
- g) heterocyclic:
 - simazine

Example 24

Claim 1: Catalyst for vapor phase oxidation of hydrocarbons, which consists of (X) or (X + a).

In this example (X) oxidizes RCH_3 into RCH_2OH and (X + a) oxidizes RCH_3 further into $RCOOH$.

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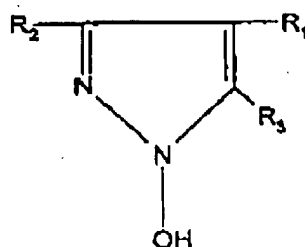
Both catalysts share a common component and a common activity as oxidation catalyst for RCH_3 . With (X + a) the oxidation is more complete and goes until the carboxylic acid is formed but the activity still remains the same.

A Markush grouping is acceptable.

IV. INTERMEDIATE/FINAL PRODUCTS

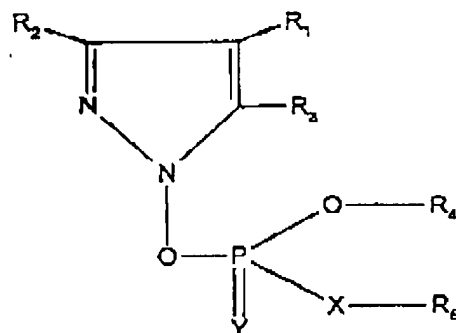
Example 25

Claim 1:



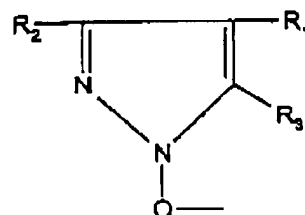
(intermediate)

Claim 2:



(final product)

The chemical structures of the intermediate and final product are technically closely interrelated. The essential structural element incorporated into the final product is:



Therefore, unity exists between claims 1 and 2.

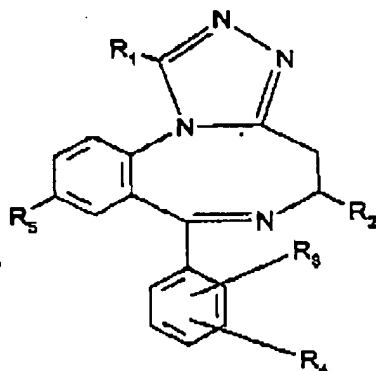
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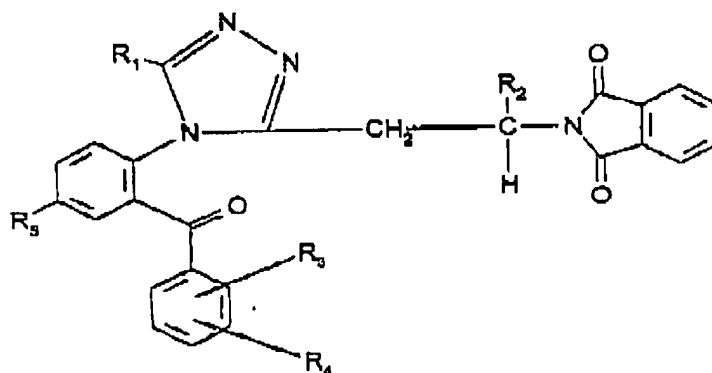
Example 26

Claim 1:



(I)

Claim 2:



(II)

(II) is described as an intermediate to make (I). The closure mechanism is one well known in the art. Though the basic structures of compound (I) (final product) and compound (II) (intermediate) differ considerably, compound (II) is an open ring precursor to compound (I). Both compounds share a common essential structural element which is the linkage comprising the two phenyl rings and the triazole ring. The chemical structures of the two compounds are therefore considered to be technically closely interrelated.

The example therefore satisfies the requirement for unity of invention.

Example 27

Claim 1: Amorphous polymer A (intermediate).

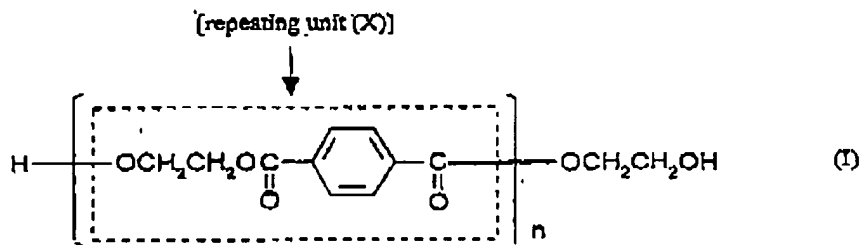
Claim 2: Crystalline polymer A (final product).

In this example a film of the amorphous polymer A is stretched to make it crystalline. Here unity exists because there is an intermediate final product relation in that amorphous polymer A is used as a starting product to prepare crystalline polymer A.

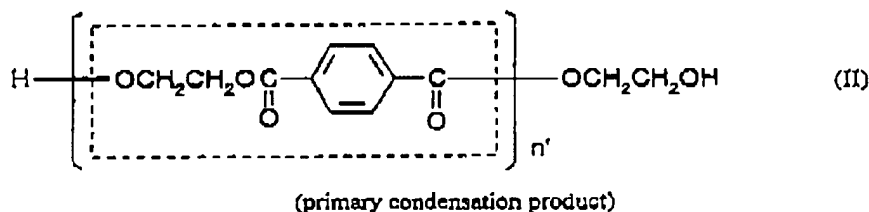
For purposes of further illustration, assume that the polymer A in this example is polyisoprene. Here the intermediate, amorphous polyisoprene and the final product, crystalline polyisoprene have the same chemical structure.

Example 28

Claim 1: Polymeric compound useful as fiber material identified by the following general formula:



Claim 2: Compound identified by the following general formula:
(useful as intermediate for polymeric compound I)



The two inventions are in an intermediate and final product relationship.

Substance (II) is a raw material for substance (I).

Meanwhile, both compounds share an essential structural element (repeating unit (X)) and are technically closely interrelated. The intermediate and final products therefore satisfy the requirements for unity.

Example 29

Claim 1: Novel compound having structure A (Intermediate).

Claim 2: Product prepared by reacting A with a substance X (Final Product).

Example 30

Claim 1: Reaction product of A and B (Intermediate).

Claim 2: Product prepared by reacting the reaction product of A and B with substances X and Y (Final Product).

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In examples 29 and 30 the chemical structure(s) of the intermediate and/or the final product is not known. In (29) the structure of the product of claim 2 (the final product) is not known. In (30) the structures of the products of claim 1 (the intermediate) and claim 2 (the final product) are unknown. Unity exists if there is evidence which would lead one to conclude that the characteristic of the final product which is the inventive feature in the case is due to the intermediate. For example, the purpose for using the intermediates in (29) or (30) is to modify certain properties of the final product. The evidence may be in the form of test data in the specification showing the effect of the intermediate on the final product. If no such evidence exists then there is no unity on the basis of an intermediate-final product relationship.

[Annex C follows]